

REMARKS/ARGUMENTS

The Office Action mailed June 15, 2009 has been received and the Examiner's comments carefully reviewed. Claims 1-20 are rejected. Claims 1, 5, 10 and 16 have been amended. The Applicants present the following for consideration.

Claim Rejections Under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action recites that "Applicant amends claim 1 to include a limitation directed to automatically incorporating the GAL contacts with the user's personal contacts. Applicant argues that this limitation distinguishes the claim over Schwartz because Schwartz discloses prompting the user before adding the GAL contact to the personal contacts. However, Applicant's specification does not provide any written description for this limitation. Applicant's amendment in fact discloses that the addition of the GAL contact to the personal list is not automatic. The section recites that a GAL contact may be added to the contact list only after the user has selected to edit the GAL contact [Fig. 6 «items 620, 630»] Applicant's printed publication 200510164651, 0046]. This teaching therefore requires a manual action in order to add the GAL contact. According to the specification, the only steps described that are performed automatically relate to the automatic selection of GAL contacts and the automatic placement of a contact into an offline GAL store [Applicant's printed publication 20050164651, 0013 & 0039]. For the foregoing reasons, Applicant's limitation directed to automatically incorporating the GAL contacts lacks written description. Because the limitation is without basis in Applicant's specification, it is ignored for the purposes of claim interpretation in this action." The Applicants respectfully disagree and present the following.

With regard to the Office Actions statements regarding Figure 6 and the editing of a GAL contact, this Figure and related discussion relates to an embodiment in which a GAL contact is added to a user's personal contacts. This is not the only way GAL contacts are added to a user's personal contacts. For example, in the Summary, the specification recites "the GAL contacts are automatically selected based on the user's emails that were sent. The GAL contacts may be selected from the user's sent items folder 'to' line. ...contacts are added based on the organizer

and attendees at meetings. ... the GAL contacts are browsed and searched seamlessly with the user's other contacts." Further, lines 15-17 on page 2 recites "The selected subset of GAL contacts are automatically selected based on the user's recent emails and/or meetings and are not duplicates of the contacts within the user's personal contact list." Still further, line 19 on page 5 to line 4 on page 6 recites in part "GAL application 312 is configured to generate a GAL associated with a user and provide the selected GAL contacts to the mobile device. Generally, sync server 310 retrieves meeting attendees, organizers and a selected number of emails from the user's email sent items box (332) on mail server 330 and determines the unique GAL contacts to be added to the GAL list from the address 'to' line of the emails. In other words, the unique GAL contacts are determined from the primary addresses within the user's sent emails. Server 310 compares the GAL contacts to the user's personal contact list to ensure there are no duplicates. Information to include the unique GAL contacts on device 320 are transmitted over a wide area network (WAN)/local area network (LAN) 340 through gateway 360 to network 350 to mobile device 320. Contacts application 322 residing on mobile device 320 is configured to receive the selected GAL contacts from server 310 and to communicate with the GAL application 312 on sync server 310. The received GAL contacts are stored in store 324 and are accessible by contacts application 322 in the same manner other contacts are accessed." Still further, on page 8, lines 10-18 provides an example that states "After Ray syncs his device with the server, his device will contain GAL contacts for people that he sent email to recently or attended a meeting with. Supposing that Ray is now away from his office and he now needs access to Kate's phone number and office number he navigates his contacts and searches for Kate D. The Contacts list shows all of the Kate D's stored in his contact list and Ray clicks on the correct Kate D. and the device displays Kate's contact info. By default, the offline GAL contacts are shown in the all contacts view." As can be seen, after the GAL contacts are automatically selected they are provided to the device and stored the contact list that includes both the GAL contacts and the user's personal contacts. As such, the Applicants respectfully request the rejection be withdrawn. As the Examiner did not address these recitations within the claims in the current Office Action, the Applicants respectfully request the next Office Action be Non-Final in order to address these recitations.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 10, 11, and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Huang et al, U.S. Patent No. 5,966,714 ["Huang"]. As amended, Claim 10 requires the steps listed to be performed. The hardware recited is configured to perform the steps, and as such, these steps are not optional. These steps should not be ignored when examining the claims. In response, the Applicants respectfully request these recitations be examined.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Schwartz et al, U.S. Patent Publication NO, 2004 0135816 ["Schwartz"] in view of Kobashikawa et al, U.S. Patent No. 7,539,699 ["Kobashikawa."]. Claims 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang and Kobashikawa, in further view of Kraenzel et al, U.S. Patent Publication No. 200510198144 Kraenzell." Claims 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang and Kobashikawa, in further view of Lake, U.S. Patent No. 7,200,638. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Kraenzel. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Lake. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Calder et al, U.S. Patent Publication No. 2001 0034244 ["Calder"].

With regard to Claim 1, the Office Action recites that automatically selecting global address list (GAL) contacts for a user to include on the device in addition to user's personal contacts that are already stored on the device [0021: tracking "non-address book message targets"]; removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts [0044: separate list of new recipients - therefore the addresses in the "non-address book" are unique]; preparing the GAL contacts [0044]; and providing the GAL contacts to the device [0044]; wherein the GAL contacts are incorporated with the user's personal contacts [0044] and wherein a display of the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view

on the device [Kobashikawa, Fig. 2 «items 172, 174»: disclosing separating addresses into different folders but within the same contact view I column 6 <line 46» to column 7 <line 7»]; such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts [0044 — the non-address book is updated while the user's personal address book is maintained]. As noted above, Schwartz does not expressly disclose a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Kobashikawa. Like Schwartz, Kobashikawa is directed to an invention for organizing contact addresses into an address book. Kobashikawa further discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders). In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user. It would have been obvious to one of ordinary skill in the art to have modified Schwartz with this same feature to better organize the user's contact list. For example, Schwartz discloses three different lists: an MFU (most frequently used) list, a list of non-address book recipients, and a general contact list. As modified by Kobashikawa, Schwartz would organize these different lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve Schwartz by better organizing the user's contacts.” In response, Claim 1 has been amended to more clearly define the invention.

Claim 1, as amended, recites in part “automatically selecting global address list (GAL) contacts on a server for a user to include on the device in addition to a user’s personal contacts that are already stored on the device; on the server, removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user’s personal contacts; preparing the GAL contacts to provide to the device including limiting a number of GAL contacts to be provided to the device; and providing from the server the GAL contacts to the device.” Among

other differences, Schwartz does not teach automatically selecting GAL contacts on a server or providing GAL contacts from the server to the device.

In contrast, Schwartz is directed at “presenting a shortened list of likely recipients from a full list of previously specified contacts such as from an electronic address book” (paragraph 11). Schwartz teaches obtaining likely recipients but does not teach automatically selecting GAL contacts on a server. Schwartz teaches keeping a list of recipients based on communications to the recipients. At paragraph 43, Schwartz recites in part that “When the user sends a mail message to a new person who is not already in the fixed list, the oldest reference entry (i.e. entry 1 of the 250) in the list is removed to make room for the newly designated mail recipient.” There is no teaching, however, that these recipients are obtained from GAL contacts on a server. Further, Schwartz teaches that in order to be considered a likely recipient the recipient must be included within the user’s address book. Paragraph 44 of Schwartz recites in part that “a potential recipient must first exist in the address book or contact list. Non-address book recipients must thus be added into the address book to facilitate identification as likely recipients. As such, a user is prompted by the present invention to add a non-address book recipient to the address book. The prompt occurs when a user enters a given non-address book recipient for the nth time. In one embodiment of the present invention, a configurable ‘n’ number of seven is utilized for prompting the user. As a result, the seventh time that a message is addressed to a non-address book recipient, the user will be prompted to add that recipient to the address book.” As can be seen, Schwartz does not teach automatically selecting GAL contacts on a server or providing the GAL contacts from the server to the device. Since Schwartz, or the other cited references, fail to teach the recitations, Claim 1 is proposed to be allowable. Claims depending from Claim 1 are proposed to be allowable as they depend on a valid base claim.

As amended, Claim 16 recites in part “automatically selecting global address list (GAL) contacts for a user that are in addition to a user’s personal contacts on the device and that are unique from the user’s personal contacts from the user’s emails; wherein the GAL contacts on the device are synchronized differently from the user’s personal contacts on the device such that when a GAL contact is deleted on the device, a record is maintained indicating to remove the GAL contact from the automatically selected GAL contacts before providing the GAL contacts

to the device during a subsequent synchronization; and wherein the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts.”

In contrast, Huang teaches generating a personal address book. Huang teaches a “method for keeping a personal address book synchronized with a master database.” (Col. 4, lines 15-18) Huang, however, does not teach that during a synchronization GAL contacts are synchronized differently depending on whether a GAL contact is deleted on the device. For example, Huang is silent regarding maintaining a record indicating that a GAL contact was deleted on the device and as such an automatically selected GAL contact that was deleted on the device is not provided to the device during a subsequent synchronization. Since the cited references do not teach synchronizing GAL as recited, Claim 16 is proposed to be allowable. Claims depending from Claim 16 are proposed to be allowable as they depend on a valid base claim.

Conclusion

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,
MERCHANT & GOULD P.C.

P.O. Box 2903
Minneapolis, MN 55402-0903
206.342.6200

/Timothy P. Sullivan/
Timothy P. Sullivan
Reg. No. 47,981
Direct Dial 206.342.6254

